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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,687	10/23/2003	Suzanne Gibson	2435U.001	6631

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EXAMINER

DURHAM, NATHAN E

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,687

Applicant(s)

GIBSON, SUZANNE

Examiner

Nathan E. Durham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/23/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 1 and 2 are objected to because of the following informalities:

- 5 Regarding claim 1, the applicant states, on page 20, line 7, "said at least one clothing accessory". It appears that the applicant meant to state the phrase, "said at least one article of clothing". If left unchanged, it appears that the statement would be considered having lack of antecedent basis and given a 35 U.S.C. 112, second paragraph rejection.
- 10 Regarding claim 2, the applicant uses the phrase, "imported image design" throughout the claim. However, the applicant states that an image design can be imported or stored using a peripheral. Therefore by stating an "imported image design", the applicant is further limiting the claim, which could result in a lack of antecedent basis and a 35 U.S.C. 112, second paragraph rejection because an imported image may not
- 15 exist (a "stored" image could exist instead). For the purpose of this Office Action an "imported image design" will be considered either an "imported image design" or a "stored image design".

Appropriate correction is required.

20

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the applicant claims a software program included in a kit.

- 5 The software program as claimed is not stored on any type of media therefore the program is not considered a physical "thing". If a computer program has no physical structure, it is considered abstract and thus cannot be placed in a kit because a kit is considered a collection of structural elements.

- Claims 17-26 are dependent from claim 16, therefore are also rejected under 35
10 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

- 15 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- 20 Regarding claim 16, on page 25, lines 10-16, the descriptions or expressions of programs are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the
25 computer program's functionality to be realized (MPEP 2106).

Claims 17-26 are also rejected under 35 U.S.C. 101 because they are dependent from the rejected base claim.

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over POSKANZER (U.S. Patent 5,943,697) in view of RIFKIN (U.S. Patent 6,116,906).

15 Regarding claims 1, 5 and 9-11 POSKANZER discloses the method of aesthetically altering articles of clothing, such as skirts, vests, rainwear, boots (i.e. shoes), hats, bookbags, handbags (i.e. purses), belts, wallets and all other forms of garments and accessories (Col. 4, Lines 15-20), by applying adhesively backed laminate stickers (200, 310) with images (240) thereon, to the clothing (100, 300) (Fig. 1
20 and Fig. 3). However, POSKANZER fails to disclose a method for designing and producing the adhesively backed laminate stickers with images thereon.

RIFKIN teaches a method for designing and producing stickers to adhere to an object in order to make the object more aesthetically pleasing in a way that is entertaining and simple for the user. RIFKIN teaches the use of a display monitor (15),
25 one or more input devices (13, 14) and a printer (20). RIFKIN teaches providing at least one object (56, 70) with a plurality of surfaces and a plurality of cloth laminate sheets

(22) wherein the printable cloth laminate sheet is cut into one or more sections to define a plurality of peelable blank covers (23-26) within the printable cloth laminate sheet (Fig. 1 and Fig. 8). The applicant discloses that die cutting a laminate sheet into sections is commonly known in the art (Applicant's Disclosure; Page 3, Lines 9-14). RIFKIN

5 teaches displaying the object (40, 56) on the display monitor (15, 50) and displaying at least one image design (53-55, 41-46) on the display monitor (51) (Fig. 1, 2 and 3).

RIFKIN teaches selecting at least one image design for use on the object (Col. 4, Lines 18-21 and 48-52). RIFKIN further teaches displaying on a display monitor the at least one object having at least one selected image design thereon (Col. 4, Lines 2-3) (Fig.

10 4). RIFKIN also teaches printing the at least one image design upon the blank cover to produce a printed cover (Col. 5, Lines 1-18) (Fig. 1). RIFKIN demonstrates applying one or more of the printed covers to one or more of the surfaces of the at least one object whereby the at least one object is aesthetically altered (Col. 5, Lines 1-18).

Accordingly, it would have been obvious to one with ordinary skill in the art at the time
15 the invention was made to have provided the method of altering clothing by applying adhesively backed laminate stickers with an image design thereon (of POSKANZER) with a method for designing and producing adhesively backed laminate stickers with an image design thereon, in light of the teachings of RIFKIN, in order to provide a more aesthetically pleasing garment in a way that is entertaining and simple for the user.

20 Regarding claims 2, 3, 13, 14 and 15, POSKANZER in view of RIFKIN teaches a method of designing and producing adhesively backed laminate stickers with images thereon in order to aesthetically alter clothing as discussed above. RIFKIN further

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teaches the use of a peripheral device for importing or storing (Col. 1, Lines 24-26) at least one image design (BACKGROUND; Col. 1, Line 44 – Col. 2, Line 50). RIFKIN teaches types of peripherals comprising computer storage means, color scanners and digital cameras (BACKGROUND examples). The Examiner wants to make it known to the applicant that the applicant's disclosure expresses that the use of peripherals such as sketch pads, digitizers, scanners, digital video cameras and still cameras are commonly used in the art to create computer images (Applicant's Disclosure; Page 2, Lines 6-13). In regards to claim 14, a color copier is being considered a scanner because a scanner copies an image to a computer. However, POSKANZER in view of RIFKIN fails to teach the peripheral device importing or storing at least one image design from the World Wide Web.

It is well known in the art for a person to save an image from the World Wide Web onto a computer's storage means in order to later print, edit, or view the image. Accordingly, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have provided the peripheral of RIFKIN with the ability to store at least one image design from the World Wide Web in order to later use the image in the design and printing of image stickers. The further aspects of applicant's claim 2, is rejected for the reasons as discussed in the previous claim 1 rejections.

Regarding claims 4 and 12, POSKANZER in view of RIFKIN teaches a method of designing and producing adhesively backed laminate stickers with images thereon in order to aesthetically alter clothing as discussed above. RIFKIN further teaches the printable cloth laminate sheets including a printable cloth sheet (23-26) releasably

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adhered to a release sheet (22) (Fig. 1). RIFKIN teaches the printable cloth sheet including a first indicia side (32, 33) for printing thereon and a second adhesive side having a pressure sensitive adhesive thereon (Refer to Abstract and Figures). In regards to claim 12, the printable sheet is considered to include embossing because

5 indicia is printed on one side of the printable sheet. The indicia is considered embossing because it is applied as an additional layer printed onto the top of the printable sheet in order to provide decoration. The adhesive side is considered to be pressure sensitive because it can be stuck onto an object by using pressure. However, RIFKIN fails to mention the release sheet being coated with a releasing agent whereby

10 the pressure sensitive adhesive releasably adheres the printable cloth sheet to the release sheet.

In the applicant's background and prior art section of the specification it is mentioned that, "various types of barrier coatings have been provided on a carrier sheet to allow release of labels with adhesive on their backs" which discloses that the use of a

15 releasing agent on a releasing sheet is considered commonly known in the art in order to provide an adequate way to easily secure and release labels from a carrier sheet so they can be placed on an object without damage to the label or adhesive (Applicant's Disclosure; Page 3, Lines 18-21). Accordingly, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have provided the release

20 sheet of RIFKIN with a releasing agent because it is well known in the art to do so in order to provide an adequate way to easily secure and release printable sheets without

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causing damage to the printable sheets or adhesive located thereon before their use on an object.

Regarding claims 6, 7 and 8, POSKANZER in view of RIFKIN teaches a method of designing and producing adhesively backed laminate stickers with images thereon in order to aesthetically alter clothing as discussed above. RIFKIN further teaches the printable covers being generally rectangular in shape (Fig. 1). However, POSKANZER in view of RIFKIN fails to teach the printable covers being sized to fit in particular sections of different shoe types. It would have been an obvious matter of design choice to size the covers to fit with particular garments, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 16, RIFKIN also teaches the use of a software program adapted for interfacing with preexisting desktop publishing software, wherein the software is constructed and arranged to set forth sequential displays appearing upon the display monitor (Col. 3, Lines 51-54) (Col. 4, Lines 5- 21).

Kit claims 16-25 are obvious over the method claims and are therefore rejected under 35 U.S.C. 103(a) for the reasons as discussed in the previous method claim rejections.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over POSKANZER (U.S. Patent 5,943,697) in view of RIFKIN (U.S. Patent 6,116,906) and in further view of CROSS (U.S. Patent 6,482,285).

Regarding claim 26, POSKANZER in view of RIFKIN teaches a method and kit for designing and producing adhesively backed laminate stickers with images thereon in order to aesthetically alter clothing as discussed above. However, POSKANZER in view of RIFKIN fails to teach the adhesive of the printable sheet being a hot melt

5 adhesive that is activated by heating.

CROSS discloses a method of creating and transferring a printable cloth sheet in which a hot melt adhesive is used in which it is activated by heating in order to securely fix an printable sheet to a garment (ABSTRACT) (Fig. 7 and Fig. 8). In addition, the examiner wants to make it known to the applicant that the use of a hot melt adhesive is

10 commonly used in the art in order to secure an opaque to a garment. Accordingly, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have provided the method and kit of POSKANZER in view of RIFKIN with a hot melt adhesive on the printable cloth sheet, in light of the teachings of CROSS, because it is common in the art in order to securely fix a printable sheet to a garment.

15

Conclusion

The prior art made of record, as cited on attached PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

The examiner wants to make it known to the applicant that the kit claims, as

20 disclosed in applicant's claims 16-26, are reference to using the kit and it's components for aesthetically altering at least one article of clothing. A kit claim is considered a collection of structural claims. "Aesthetically altering at least one article of clothing" is

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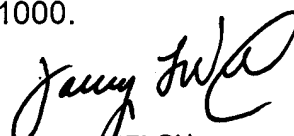
not a structural claim and is purely functional and therefore receives no weight in the corresponding kit claims. For future reference, the Examiner also wants to make it known to the applicant that the content of printed matter will not distinguish a claimed product from prior art when the printed matter is not functionally related (In re Ngai, 367

5 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan E. Durham whose telephone number is (571) 272-8642. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for
15 published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
20 USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


GARY L. WELCH
PRIMARY EXAMINER